

REMARKS

This is in full and timely response the Office Action mailed on November 23, 2004. Reexamination in light of the following remarks is respectfully requested.

Claims 13-25 are currently pending in this application, with claim 13 being independent.

No new matter has been added.

Rejection under 35 U.S.C. §103

Claims 13-20 and 22-23 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent 5,727,777 to Chikiri et al. (Chikiri) in view of www.flagtelecom.com (Flag Telecom).

This rejection is traversed at least for the following reasons.

“The Patent and Trademark Office (PTO) has the burden of showing a prima facie case of obviousness.” *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). “In determining the propriety of the Patent Office case for prima facie obviousness, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the proposed substitution or other modification.” *In re Taborsky*, 183 USPQ 50, 55 (CCPA 1974). Moreover, *prima facie* obviousness of a claimed invention is established “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Claim 13:

Claim 13 is drawn to a method for building the overhead infrastructure comprising the steps of:

installing a basic construction, said basic construction including utility poles, a tensile line drawn between said utility poles, a plastically deformable coil suspended by said tensile line, and an overhead cableway, said overhead cableway being the space bounded by said plastically deformable coil; and

renting or selling a portion of said overhead cableway to a business conductor, wherein an administrator rents or sells said portion to said business conductor.

The Office Action admits that renting or selling a portion of said overhead cableway to a business conductor, wherein an administrator rents or sells said portion to said business conductor is not found within Chikiri. The Office Action cites Flag Telecom for these features admittedly deficient from within Chikiri.

In response, page 1 of Flag Telecom appears to show a copyright date of 2001. However, the above-identified application has an actual filing date of November 7, 2001 and an effective filing date of July 30, 2001. As a result, there is some question as to whether or not the copyright of 2001 shown on page 1 of Flag Telecom is, in fact, earlier than the actual or effective filing date of the above-identified application. Thus, the Office Action fails to show that the Flag Telecom reference is, in fact, prior art against the above-identified application.

In addition, Flag Telecom arguably teaches that Flag offers customers the choice of buying or leasing capacity (Flag Telecom at page 6). However, Flag Telecom fails to show that the overhead cableway is the space bounded by the plastically deformable coil and fails to show that buying or leasing capacity arguably taught in Flag Telecom is equivalent to renting or selling a portion of the overhead cableway. While the Office Action contends that Flag Telecom teaches that a cableway can be sold or leased (Office Action at page 3), the renting or selling of a portion of the space bounded by the plastically deformable coil is absent from within Flag Telecom.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 16:

Within claim 16, the business conductor extends at least one overhead line along overhead cableway.

The Office Action contends that it would have been obvious to the skilled artisan to purchase or lease Right Of Way from property owners.

In response, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). However, this contention is merely a personal conclusion that is unsupported by any objective evidence.

As a rule, “assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious” (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)(rejection based upon hindsight is reversed).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner's affidavit upon request. Specifically, “when a

rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” 37 C.F.R. §1.104(d)(2).

Also note that the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

In addition, this assertion amounts to nothing more than an “obvious-to-try” situation. Specifically, “an ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, “an invention is ‘obvious to try’ where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful.” *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. “Obvious to try” is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 17:

Within claim 17, the business conductor manages at least one overhead line.

The Office Action admits that Chikiri in view of Flag Telecom fails to teach that the business conductor manages at least one overhead line, but contends that the business conductor that manages at least one overhead line would have been obvious to the skilled artisan (Office Action at page 5).

In response, this contention is merely a personal conclusion that is unsupported by any objective evidence.

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 18:

Within claim 18, the administrator provides the business conductor with rights for using the overhead cableway for rent or for sale with a fee according to a number and weight of at least one overhead line managed by the business conductor.

The Office Action contends, without providing any objective evidence, that it is a business choice to decide on fee structure (Office Action at page 5).

In response, this contention is merely a personal conclusion that is unsupported by any objective evidence.

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 20:

Within claim 20, prior to the step of installing the basic construction, the method further comprises the steps of: estimating the number of overhead lines to be extended within the overhead cableway; and estimating a maximum load supported by the overhead cableway, the weight for the number of the overhead lines and the distance between the utility poles being used to estimate the maximum load.

The Office Action takes Official Notice that it would have been obvious to the skilled artisan that business is known to make estimations prior to starting a construction project (Office Action at page 6).

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 22:

Claim 22 provides that the number is an integer greater than one.

The Office Action contends Chikiri in view of Flag Telecom provides that the number is an integer greater than one.

In response, Chikiri arguably teaches the presence of cable 19 (Chikiri at figure 5, column 3, lines 61-62). Nevertheless, Chikiri in view of Flag Telecom fails to provide that the number is an integer greater than one.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 23:

Claim 23 provides that the number determines the section area of the overhead cableway.

The Office Action contends Chikiri in view of Flag Telecom provides that the number determines the section area of the overhead cableway.

In response, this contention is merely a personal conclusion that is unsupported by any objective evidence.

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Claim 24:

Claim 24 provides that the plastically deformable coil has a metal wire formed in a spiral shape and synthetic resin coated on a surface of said metal wire.

The Office Action admits Chikiri in view of Flag Telecom fails to teach that the plastically deformable coil has a metal wire formed in a spiral shape and synthetic resin coated on a surface of said metal wire, but instead, is a business and design choice.

In response, this contention is merely a personal conclusion that is unsupported by any objective evidence.

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, *Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known.* Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claims 21 and 25 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Chikiri in view of Flag Telecom and U.S. Patent No. 5,789,701 to Wettengel et al. (Wettengel).

This rejection is traversed at least for the following reasons.

Within claim 25, the step of installing said basic construction comprises the steps of: drawing said tensile line between said utility poles; surrounding said tensile line axially with said plastically deformable coil; attaching a portion of said plastically deformable coil to said tensile line with a cram member; and elongating said plastically deformable coil along said

tensile line from said cram member toward one of said utility poles to form said overhead cableway.

The Office Action admits that Chikiri in view of Flag Telecom and Wettengel does not teach the project implementation plan for the overhead infrastructure, but contends that the steps of claim 25 would have been obvious nonetheless (Office Action at page 8).

In response, this contention is merely a personal conclusion that is unsupported by any objective evidence.

In this regard, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989). Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Thus, all features are not found within Chikiri or Flag Telecom, either individually or as a whole.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

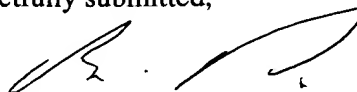
For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: January 14, 2005

Respectfully submitted,



By _____

David T. Nikaido

Registration No.: 22,663

Brian K. Dutton

Registration No.: 47,255

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorneys for Applicant